

Application SN
09/745,669

REMARKS

Claims 1-7, 28 and 31-32 are now pending in the application.

Claims 17-24 have been canceled.

Claims 1, 7 and 28 are independent.

Prior Art Rejections

Claims 1-6, 7, 28, 31 and 32 were rejected under 35 USC 103(a) as being unpatentable over the "personal barcode scanning technology taught in the article 'Swipe Your Shopping' (Field, Chris, March 11, 1998, The Times)" in view of US Patent 5,047,614 (Bianco).

Claims 17-24 were rejected as being unpatentable over "Qode, as described in the webpages of www.qode.com excised using The Wayback Machine – web.archive.org – dated 10/18/2000, the article "Get Ready to Pocket a Personal E-shopper" (Joshi, Pradnya, Oct. 22, 2000. South Florida Sun – Sentinel), and the WRS Press Release 'Qode Teams with QRS to Give On-land and On-line Retailers Advanced Marketing Capabilities – dated Oct 03, 2000".

Of course the cancellation of Claims 17-24 renders the rejection of those claims moot.

The rejection as to the remaining claims based on Field and Bianco is respectfully traversed and reconsideration is requested.

Independent Claim 1 is directed to an apparatus for retrieving information related to a consumer product using a consumer product codes. The apparatus includes a portable consumer good that lacks the capacity for data transmission and a scanning and storage device in mechanical communication with the portable consumer good. The scanning and storage device includes (i) a scanning element converting a product code symbol into machine readable information representative of the product code, and (ii) a removable memory medium to which the information is stored.

Independent Claim 7 also recites that the apparatus includes an Internet-ready device couplable to one or more Internet-based information servers, the Internet-ready device including a removable memory medium adapted to accept the removable memory medium from the scanning and storage device.

Application SN
09/745,669

Independent Claim 28 is directed to a method for retrieving information related to a consumer product comprising the steps of integrating a bar code scanner and a removable memory into a consumer good that is *a non-electronic device*, scanning a bar code and storing the scanned bar code in the removable memory, and accessing a web site based on the scanned bar code, wherein the web site includes information related to the selected consumer product.

In the rejection of Claims 1-6, 7, 28, 31 and 32 as unpatentable in view of the alleged teachings of Field and Bianco, the Action takes the position that “Field discloses the integration of barcode scanning technology in everyday items...including a cellular phone and a ballpoint pen...the data from the scanned barcode is stored in the pen and downloaded when the pen is connected to a home PC via a ‘data well’”.

The Action acknowledges that “Field does not explicitly disclose that the bar code scanner is embedded in a consumer good that *lacks the capacity for data transmission*”, noting that, in fact, “the pen is capable of *both* wireless and contact-based data transmission” (emphasis added herein).

The Action then turns to the alleged teachings of Bianco (specifically directed to a device manufactured and intended only for barcode scanning), and states that Bianco allows a consumer to “scan the barcodes of items that she wishes to purchase” and a “smart card (removable memory) is inserted into a slot in the terminal where it is left while data is being accumulated” and is “removed from the terminal and used elsewhere to retrieve the desired product information”. The Action acknowledges that Bianco, “does not explicitly teach that the scanning and storage device are embedded in a ‘portable consumer good’”.

The Action concludes that [because] “the barcode scanning device of Bianco and embedded barcode scanning devices in Field serve the same purpose: convenient and timely storage of information about a customer’s desired purchases for later use...” it would have been “obvious to modify the system of Field – whereby a consumer uses a barcode scanner embedded in a consumer good to select desired goods, transfers the data to a computer to learn more about selected products via the Internet – to transfer the data from the scanner to the computer using any means – connected or otherwise”...., as taught by Bianco, since it has such advantages as “allowing a customer to store more information across multiple cards – thereby eliminating restraints on their use of the scanning device when ordering items”.

Application SN
09/745,669

As discussed in paragraph [0013] of Applicants' specification, the present invention integrates a bar code scanning and retrieval system into a consumer device that has an otherwise main and different function or purpose – enabling significantly deeper product penetration into the marketplace. The information scanned by a “non-Internet-ready portable consumer good” can be subsequently transferred to an Internet-ready device by means of removable memory.

The example provided in paragraph [0032] of Applicants' specification, is that of a “CD-player”, that includes a memory, for example a smart card, which can be removed and inserted in another system for connecting to a web site”. Other “non-electronic” portable consumer goods include “clothing, pocketbooks, etc”.

Field, on the other hand, not only did not appreciate the possibility of an apparatus for retrieving and processing information related to a consumer product using a universal product code comprising a portable consumer device that “lacks the capacity for data transmission”, Field very specifically required a device that “contains radio technology which will let it connect to the wireless communications networks now operating in some larger stores”, and notes that “as soon as the phone comes within range, the network will pick up the shopping list and communicate the information to the back office...”.

Of course to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference*. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed *modification* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). 706.02(j) [emphasis supplied].

Applicants respectfully submit that the Field and Bianco references fail to meet this requirement of obviousness. Field very clearly teaches *away from* any inclination to modify its teachings in view of the alleged teachings of Bianco (which, again, is directed to a specific “non-consumer” device – a bar code scanner designed only to scan bar codes, with no other “unrelated” functionality).

Application SN
09/745,669

Therefore, Applicants submit that Field and Bianco do not teach or suggest, and one of ordinary skill in the art would not anticipate, in light of their teachings, an apparatus such as that recited by Applicant's independent Claims 1, 7 and 28 a portable consumer good that *lacks the capacity for data transmission, and a removable memory medium to which the product code information is stored.*


For at least the foregoing reason, Applicant submits that independent Claims 1, 7 and 28 are patentable over Field and Bianco and reconsideration is respectfully requested.

Claims 2-6 and 31-32 depend from independent Claim 1 or 28 and recite further limitations that even further distinguish over the art of record. It is respectfully submitted that remaining pending Claims 1-7, 28 and 31-32 are patentable over any permissible combination of the teachings of Field and Bianco.

Request for Telephonic Interview

Should the Examiner maintain the rejection based on Field and Bianco, despite Applicants' discussion above, Applicants respectfully requests that the Examiner telephone Applicants' undersigned representative at (908) 518-7700 in order that any outstanding issues be resolved.

Respectfully submitted,


Karin L. Williams
Registration No. 36,721

Certificate of Facsimile Transmission

I hereby certify that this document and any document referenced herein has been transmitted via facsimile to the US Patent and Trademark Office at (703) 872-9326 on August 23, 2004.

Karin L. Williams, Reg. No. 36,721.

(Printed Name of Person Mailing Correspondence)


(Signature)

Application SN
09/745,669

Please Continue to Send All Correspondence to:

Mayer, Fortkort & Williams PC
251 North Avenue West, 2nd Floor
Westfield NJ 07090
(908) 518-7700
(908) 518-7795 fax